

REMARKS

Claim 1 and the claims dependent thereon have been amended. Claims 4-5 and 13-20 remain canceled. Claims 9-12 are allowed.

The Office Action states:

Claims 1-3, 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sciammarella et al. US Patent 6425129.

Regarding claims 1 and 8, Sciammarella et al. teaches a method comprising: providing, to a user of a remote control device having a display, a graphical item representative (element 802 in figure 8A) of an indication of a value representative of a current preset associated with the sound signal source (cot. 8 lines 43-54) and providing the user with the option to change the current value to a new value (col. 8 lines 51-60).

Regarding claim 2, Sciammarella et al. teaches the presets is associated with a sound signal source in a multi-media system (col. 2 lines 44-50).

Regarding claim 3, Sciammarella et al. teaches multi-media system produces audio and video and therefore comprises an audio system (col. 3 lines 31-40). Regarding claim 7, Sciammarella et al. teaches the remote control communicates with a second device (2) to effect change to the new preset value (col. 4 lines 60-63).

Pp. 2-3.

This ground of rejection is respectfully traversed.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 76 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

Amended claim 1 calls for "providing to a user of a control device having a display, a graphical item representative of an indication of a value currently representative of a current preset associated with a sound signal source, the current preset having been pre-selected by the user as being of interest."

This limitation must be interpreted in the light of paragraph 27 of the specification which reads as follows:

[0027] The remote control unit 50 also includes a presets button 66. When a user presses the presets button 66, a list of presets is displayed on the display 52. A

preset list is, for example, a list of stations within a source, for example, FM stations within the source called FM, which have been pre-selected as being of interest. When a preset source is selected (by an indication given by the user), the music system changes its state in response to the indication or selection and plays from the station associated with the selected preset. When the source is a broadcast radio station, of course, once the user selects the station, he has no control over the selection or sequence of what is played. "It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force

the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

The reference does not disclose any current presets that were preselected by the user as being of interest. The reference only discloses displaying all of the channels from which the user may select a channel to view. There is no disclosure of a preset in the reference. Accordingly, withdrawal of the rejection of claims 1 and 8 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each limitation in at least claim 1.

The Office Action states:

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sciammarella et al. US Patent 6425129 in view of Obayashi et al. US Patent 5404579.

Regarding claim 6, Sciammarella et al teaches providing the user with an option to change the value of a preset (col. 8 lines 51-60) but is not explicit in teaching enabling a user to confirm the possible new preset value. Obayashi et al. in an art related invention in the same field of endeavor of remote control teaches allowing a user to confirm the data entered at the remote control in order to ensure that the correct control data was entered (col. 4 lines 22-24).

It would have been obvious to one of ordinary skill in the art to modify the system of Sciammarella et al. as disclosed by Obayashi et al. because allowing a user to confirm the data entered at the remote control ensure that the correct control data was entered for activating a desired function. P. 3.

This ground of rejection is respectfully traversed. Claim 6 is dependent upon and includes all the limitations of claim 1. We have shown above that the primary reference fails to anticipate claim 1; therefore, it is impossible to combine the references to meet the limitations of claim 6.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of claim 6 is reason enough for withdrawing the rejection of it. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references corresponding to each limitation in claim 6.

The courtesy of the Examiner in setting forth reasons for allowance of claims 9-12 is acknowledged with appreciation. There may be other reasons that support the patentability of claims 9-12.

In view of the foregoing amendment, authorities, remarks and the inability of the prior art to anticipate, suggest, or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the Examiner believes the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps he believes are necessary to place the application in a condition for allowance.

Applicant : William Allen et al.
Serial No. : 10/752,391
Filed : January 6, 2004
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Attorney's Docket No.: 02103-0581001 / AABOSW35

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,
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2 July 2009

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